

### **REMARKS**

Claims 14-44 and new claim 45 are pending in this application. In this response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

In particular, claims 14 and 24 were amended to clarify that the steps described in the method occur in a processing station having both an application apparatus and an automated inspection system. The processing station of claim 14 additionally has a curing apparatus within the processing station. Support for these amendments are found throughout out the specification, such as, for example, in the paragraph at page 8, lines 9-20.

Applicants also have added new claim 45, which depends from claim 31. Since the only reference relied upon by the Examiner is for a system that measures the thickness of a spay coated film, claim 45 clarifies that an indicia may comprise a ball number, brand name, or company name, none of which is discussed or suggested by any reference relied upon by the Examiner. New claim 45 is supported at page 1, lines 21-22.

As no new matter has been added by the amendments herein, Applicants respectfully request entry of these amendments at this time.

### **THE PROVISIONAL DOUBLE PATENTING REJECTION**

The Examiner provisionally rejected claims 14-44 under 35 U.S.C. § 101 as claiming the same invention as that of claims 14-27 of copending Application No. 10/292,635. Applicants request the Examiner reconsider and withdraw this rejection for at least some of the pending claims in this application. Of the 30 claims pending in this application, none are identical to each other, yet the examiner has indicated that the 13 claims of the '635 application are the same invention.

Since this is a provisional rejection Applicants will consider amending claims in either this or the '635 application if conflicting claims are found allowable.

**THE REJECTIONS UNDER 35 USC § 102**

The Examiner rejected claim 14-16, 19-20, 22-25, 27-28, 30-31, 33, 36-39, 41-42, and 44 under 35 USC § 102 as being anticipated by Japanese patent JP 08 309 262 to Yamada for the reasons provided on page 3 of the Office Action. Of these claims, only claims 14, 24, 31, and 37 are independent. Applicants respectfully traverse this rejection for the following reasons.

The Yamada '262 reference is directed to a method for determining when a spray coating machine needs adjustment by measuring the thickness of the spray coating applied to the entirety of a golf ball. According to Yamada '262, the entire surface of a golf ball is spray coated with a film of material. The entire surface of the ball is then irradiated with UV light and a data analyzer determines only whether the thickness of the film meets a minimum threshold. If the minimum threshold is not met, the spray coating machine can then be adjusted so that the film thickness once again exceeds the minimum threshold. Although not explicitly explained in the text of Yamada, it is believed that a UV light is used because the coating is a clear top coat of the golf ball that is not visible to the naked eye.

With respect to claim 14, there is no discussion anywhere in Yamada about providing a processing station comprising all three of (1) a surface treatment application apparatus, (2) an automated inspection system, and (3) a curing apparatus. While Yamada does discuss inspecting the film thickness of a spray coating, there is nothing in the reference that discusses performing both of these steps in the same processing station. In fact, none of the figures illustrates a spray gun coating machine. Had Yamada intended to combine these elements into a single processing station, they would have been illustrated together and described as such in the specification. Moreover, Yamada is completely silent as to providing a curing apparatus as presently recited in claim 14. Nor would it be obvious to provide a curing apparatus for the system of Yamada since spray coated films such as those described in Yamada typically do not involve a curing apparatus. For at least these reasons Yamada does not anticipate claim 14.

With respect to claim 24, once again there is no discussion anywhere in Yamada about providing a processing station comprising both a coating application apparatus and an automated inspection system. Yamada is silent regarding at least this feature of the claimed invention. As discussed above, the figures and specification suggest that the spray gun coating machine is separate from the coating film detector. In contrast, the specification and

figures of the present invention explicitly illustrate and describe combining these elements into a single processing station. *See, e.g.*, Fig. 6 and related discussion on pages 27-28.

With respect to claim 31, Applicants respectfully submit that there is no discussion anywhere in Yamada describing inspection of an indicia. The plain and ordinary meaning of the term indicia is an identifying mark, such as a ball number, company name, a logo, printed text, a symbol, or the like. Dictionary definitions of this term likewise support this ordinary meaning. One benefit of providing an indicia on a golf ball is that it enables a golfer to distinguish his ball from another golfer's during play. A spray coated film covering the entire golf ball, however, would not result in an indicia that would allow a golfer to identify the ball. This is particularly the case where, as here, it is believed that the coating of Yamada is a clearcoat, and therefore not visible to the naked eye. Furthermore, Yamada only teaches to check the film coating by illuminating it under UV light and looking for a minimum threshold. This teaching is not sufficient for inspecting an indicia. For instance, under the present invention the application of too much ink, such as a smudge or smear, would mean that the indicia does not meet a predetermined standard. In contrast, Yamada only looks for a minimum threshold and therefore would not identify a defect involving too much ink.

Claim 37 also is not anticipated by Yamada for the same reasons provided above for claim 31. Specifically, a logo print is not similar to a spray coated film covering the entire ball as described in Yamada. Logo prints are visible to a golfer's eye and help identify a ball or distinguish it from other golf balls, whereas a clear coat as described in Yamada would not be visible to a golfer. Additionally, the manner in which Yamada teaches to provide only a minimum film thickness threshold would not fulfill the step of determining whether a logo conforms to a predetermined standard.

For at least these reasons, Applicants submit that none of independent claims 14, 24, 31, and 37 is anticipated by Yamada.

#### **THE REJECTIONS UNDER 35 USC § 103**

The Examiner rejected claims 17-18, 21, 26, 29, 32, 34-35, 40, and 43 under 35 USC § 103(a) as being unpatentable over Yamada '262 in view of U.S. Patent No. 5,181,081 to Suhan for the reasons provided on pages 4-5 of the Office Action. Applicants respectfully traverse.

First, Applicants note that all of these claims depend from one of the independent claims discussed above, namely claims 14, 24, 31, and 37. As explained above, however, Yamada fails to anticipate any of these independent claims. Therefore, the dependent claims rejected as obvious are allowable at least by virtue of their dependence upon allowable base claims.

Moreover, the Examiner's suggestion to combine these references ignores the explicit teaching in Suhan not to make such a combination. Specifically, Suhan teaches that the system described therein is specifically designed for the optical conditions of inspecting labels on compact discs, for which a conventional system such as Yamada would not work because of the reflective diffraction of the discs, the insufficient sensitivity of prior systems, and because of the lack of any provision to inspect for added or superfluous ink. As discussed above, the system described by Yamada is similar to the systems Suhan explicitly states do not work for its intended purpose. *See, e.g.,* Suhan at col. 1, lines 20-26.

Additionally, Yamada teaches to inspect the entire surface of a ball, whereas Suhan teaches to contain or limit inspection to only the area where a label is located. *See, e.g.,* Suhan abstract.

Furthermore, Suhan, like Yamada teaches away from the invention of claims 14 and 24 by stating that steps of printing the label and inspecting the label take place at different stations. *See, e.g.,* Suhan at col. 2, lines 37-45. Thus, even if these two references could be combined, they would not result in the claimed invention as recited in claims 14 and 24.

For these reasons, Applicants respectfully submit that the rejections based upon Kumagai and Masutani fail to show *prima facie* obviousness. Simply stated, the Examiner must show three required elements for obviousness: (1) there must be motivation to combine the references; (2) there must be a reasonable expectation of success; and (3) the combination must teach all the claim features. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The burden of proving these elements rests with the Examiner. Here, the Examiner has not shown elements 1 and 3. Absent this showing by the Examiner, Applicants believe that the rejections under 35 U.S.C. § 103 have been overcome. Applicants therefore respectfully request reconsideration and withdrawal of these rejections.

**CONCLUSION**

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments and remarks still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith, with provision for the required fee, to extend the time for response two months to and including November 4, 2003. A fee sheet is also provided for payment for new claim 45. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 195127, Order No. 20002.0093.

Respectfully submitted,  
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By: 

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